

Application No.: 09/937,313
Inventor: BERNDL et al.
Reply to Office Action of 02 March 2006
Docket No.: 49860

REMARKS/ARGUMENTS

Claims 10-12 and 14-28 are pending. Support for amended claim 21 can be found in the specification on at least on page 2, lines 9-14 wherein an excipient of the invention is described. Support for new claims 22-24 can be found in the claims as originally filed and in the specification beginning on page 1, line 44 to page 2, line 14. Support for new claim 25-28 can be found in the claims as originally filed, and in the specification on page 2, lines 9-14 and page 4, lines 38-42. No new matter has been added in the amended claims.

Rejection under 35 USC §112 ¶1

Claim 21 is rejected for allegedly failing to comply with the written description requirement. Applicants respectfully disagree. Nonetheless, without agreeing with either the reason for or the rejection of claim 21, the claim has been amended to better illustrate the claimed subject matter. In light of the amendment, Applicants respectfully request withdrawal of the 112 rejection.

Rejection under 35 USC §103

Claims 10-12 and 14-21 stand rejected as allegedly unpatentable. Applicants respectfully disagree.

To establish *prima facie* obviousness, the Examiner must show in the prior art some suggestion or motivation to make the claimed invention, a reasonable expectation for success in doing so, and a teaching or suggestion of each Claim element (*See, e.g., In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ 2d 1941 (Fed. Cir. 1992); *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986); *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)). Most inventions arise from a combination of old elements and each element may often be found in the prior art (*In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998)). However, mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole (*Id.* at 1355, 1357). Rather, to establish a *prima facie* case of obviousness based on a combination of

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elements disclosed in the prior art, the Examiner must articulate the basis on which it concludes that it would have been obvious to make the claimed invention (*Id.*). In practice, this requires that the Examiner "explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious" (*Id.* at 1357-59). This entails consideration of both the "scope and content of the prior art" and "level of ordinary skill in the pertinent art" aspects of the *Graham* test.

Applicants respectfully incorporate their previous assertions regarding the referenced art of record and 103 rejection, and further assert the following:

The Examiner rejected claims 10-12, 14 and 17-21 over the disclosures of Ball et al. and Guzi et al. Applicants respectfully assert that Ball et al. discloses the preparation of a powderous cross-linkable composition having a) a water insoluble polymer, b) a water soluble polymer and c) a di-functional compound as a crosslinker. The water insoluble polymer a) is obtained by emulsion polymerization in an aqueous medium. Because this polymer is obtained from equally water insoluble monomers such as dienes, olefins, and vinyl esters (*See* col. 2, ll. 29-46), the emulsion polymerization is carried out in the presence of up to 6 % by weight, based on the total weight of the monomers (*See*, col. 6, ll. 4-9), of emulsifiers. The emulsifiers include, for example, anionic or nonionic surfactants. The resulting polymer dispersion can be spray dried in the presence of a protective colloid such as the water soluble polymer b), e.g. polyvinyl pyrrolidone. The powderous compositions are intended for application in building compositions (*See* claim 6) or as binders for paper. In sum, the disclosure of Ball et al. is unrelated to an excipient comprising a surfactant. Applicants respectfully assert that the surfactant of Ball et al. is only present because the required water insoluble polymer a) is obtained by emulsion polymerization that otherwise would not work.

Applicants respectfully assert that Guzi et al. discloses dry pigment compositions comprising 55 to 80% of a pigment and 45 to 20% of a nonionic material. The nonionic material is formed from a nonionic dispersing agent and a polymer such as polyvinylpyrrolidone. A homogeneous mixture of the pigment and the nonionic material is formed and dried. Formation of the homogenous can be performed by mixing the components in a single stage or by mixing

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the pigment in the presence of water with the nonionic dispersing agent followed by addition of the polymer and then drying. Accordingly, Applicants respectfully assert that Guzi et al. discloses the preparation of dry pigment compositions and does not teach the preparation of an excipient, because the pigment serves as an active ingredient in the compositions.

Applicants respectfully assert that known compositions do not render an invention obvious simply because they could be combined; to establish a *prima facie* case of obviousness, the Examiner must provide a rationale for the combination. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination¹. The motivation to combine must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be disregarded². The Examiner on page 5 of the 02 March 2006 Office Action states that "it would have been obvious to follow the suggestions of the '865 reference and include the surfactants of the '422 reference into the process" without providing in the analysis of Ball et al and Guzi et al. Applicants respectfully assert that the Examiner has not provided the required objective evidence of a motivation or suggestion to combine the art references cited the expectation for success practicing the instant invention. If the Examiner has personal knowledge regarding the motivation or suggestion to combine, Applicants respectfully request submission of an Examiner's affidavit and thereafter be provided a full and fair opportunity to respond. In the absence of such evidence or an affidavit, Applicants respectfully request that this rejection be

¹ See, *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990).

² See, e.g., *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'") (quoting *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998)); *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); *In re Dance*, 160 F.3d 1339, 1343 (Fed. Cir. 1998) ("there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant"); *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988) ("teachings of references can be combined only if there is some suggestion or incentive to do so.") (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577 (Fed. Cir. 1984)).

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withdrawn.

Nonetheless, assuming *arguendo* that the combination of the art references is proper, the combination fails to teach suggest or disclose the claimed invention. Applicants respectfully assert that the formulations of the "active" pigment and excipients of Guzi et al. combined with the surfactant of Ball et al., which is only present because the required water insoluble polymer a) is obtained by emulsion polymerization fails to allow one of ordinary skill in the to practice the claimed invention.

In light of at least the above, withdrawal of the 103 rejection is hereby requested. Independent claim 10 stands free of *prima facie* obviousness. Claims 11-12, 14-21 depend from claim 10 and as such, also stand free of *prima facie* obviousness. As the Federal Circuit stated in *In re Fine*, "[d]ependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious" (837 F.2d at 1076). Accordingly, because *prima facie* obviousness has not been established, Applicants respectfully request withdrawal of the 103 rejection.

Nonetheless, in view of the rejection of claims 15-16, Applicants respectfully assert that the claims are non-obvious in light of the referenced art. The Examiner asserts that a skilled artisan would be motivated to combine the surfactant of Shih et al. with the process of Ball et al. because they both combine water-soluble emulsifiers. However, Applicants respectfully assert that there is no such motivation for the skilled artisan because Ball et al. use the surfactant for the polymerization of a water-insoluble polymer of its disclosed composition. Accordingly, one of ordinary skill in the art would not have the motivation to combine the art references suggested by the Examiner with the expectation for success practicing the claimed invention.

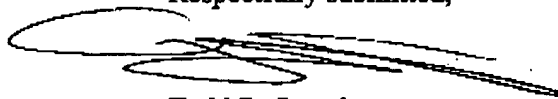
For at least the reasons expressed above, it is urged that the art references cited by the Examiner, either singly or in combination, fail to teach, suggest or disclose the present invention as defined by the claims. Accordingly, a *prima facie* case of obviousness has not been established by the Examiner, and the rejection under 35 USC § 103 should be withdrawn. Favorable action is solicited.

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Conclusion

Applicants respectfully submit that the present application is in condition for allowance, which action is courteously requested. Please charge the two-month extension fee to the credit card listed on the enclosed Form PTO-2038. Please charge any shortage in fees due in connection with the filing of this paper to Deposit Account 14.1437. Please credit any excess fees to such account.

Respectfully submitted,



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